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APPLICATION NO.	FILING DATE	FIRST NAMED INVENTOR	ATTORNEY DOCKET NO.	CONFIRMATION NO.
10/613,281	07/03/2003	Michael David Brookshire	0538.001	4021

26707 7590 07/25/2006

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EXAMINER

LAVINDER, JACK W

ART UNIT	PAPER NUMBER
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3677

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Please find below and/or attached an Office communication concerning this application or proceeding.



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APPLICATION NO./ CONTROL NO.	FILING DATE	FIRST NAMED INVENTOR / PATENT IN REEXAMINATION	ATTORNEY DOCKET NO.
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EXAMINER

ART UNIT

PAPER

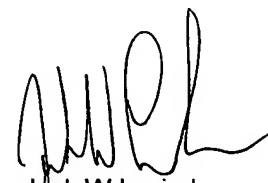
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Commissioner for Patents

The IDS statements filed on 4/12/2006 have not been considered since they are missing a 1.97(e) statement. The statements were filed after a final rejection. 1.97 requires that these IDS statements must be accompanied by a 1.97(e) statement and the appropriate fee in order to be considered. The fee has been included, but the statement is missing.



Jack W Lavinder
Primary Examiner
Art Unit: 3677



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**BEFORE THE BOARD OF PATENT APPEALS
AND INTERFERENCES**

Application Number: 10/613,281
Filing Date: July 03, 2003
Appellant(s): BROOKSHIRE, MICHAEL DAVID

MAILED

JUL 25 2006

GROUP 3600

Robert D. Atkins
For Appellant

EXAMINER'S ANSWER

This is in response to the appeal brief filed 4/24/2006 appealing from the Office action mailed 11/22/05.

(1) Real Party in Interest

A statement identifying by name the real party in interest is contained in the brief.

(2) Related Appeals and Interferences

The examiner is not aware of any related appeals, interferences, or judicial proceedings, which will directly affect or be directly affected by or have a bearing on the Board's decision in the pending appeal.

(3) Status of Claims

The statement of the status of claims contained in the brief is correct.

(4) Status of Amendments After Final

No amendment after final has been filed.

(5) Summary of Claimed Subject Matter

The summary of claimed subject matter contained in the brief is correct.

(7) Claims Appendix

The copy of the appealed claims contained in the Appendix to the brief is correct.

(8) Evidence Relied Upon

250378	Meyer	12-1881
D35938	Schenck	06/1902
D43724	Schenck	03/1913

Vargas, Glenn & Martha, "Diagrams for Faceting" Volume II, Desert Printing Co., Indio, CA 1986.

(9) Grounds of Rejection

The following ground(s) of rejection are applicable to the appealed claims:

Claims 25-44 have been rejected under 35 U.S.C. 112, second paragraph, as being indefinite for failing to particularly point out and distinctly claim the subject matter which applicant regards as the invention.

The phrase “naturally occurring precious gemstone” in the preamble of the claim is considered to be indefinite. The preamble claims “A naturally occurring precious gemstone,” whereas the body of the claim is directed to a stone that has been cut, ground and polished by a craftsperson. How can a cut precious stone be considered as a stone that occurs in nature? Furthermore, this type of language borders on the edge of being non-statutory subject matter under 101. An applicant cannot claim something that naturally occurs in nature. The examiner would make a 101 rejection, but feels that the issue is better handled using 112-second paragraph. From viewing the body of the claims, it is clear that the appellant is not trying to claim something that has naturally occurred in nature. The body of the claims discusses all the different cut facets in the stone, which could never naturally occur in nature.

The phrase “naturally occurring precious gemstone” throughout the claims is considered to be indefinite. A gemstone by definition is considered to be a stone that has been altered in some way by human hands to turn it into a gemstone. The alteration is usually performed by cutting or grinding the stone to form facets. The facets improve the light refraction of the stone. Clearly, a precious gemstone cannot naturally occur. It must, by definition, be formed by human hands.

Claims 25-44 have been rejected under 35 U.S.C. 103(a) as being unpatentable over the Diagrams for Faceting reference in view of Meyer, 250378, Schenck, D35938 and Schenck, 43724.

Regarding claims 25-44, the Diagrams for Faceting reference discloses a variety of faceting designs for use on precious naturally occurring stones. On page 9, the Mogul cut discloses eight rows of crown facets with the same number of facets in each row. The facets are cut at varying degrees of angles from a reference plane tangent to the top of the crown. The reference also discloses, on page 16, a pavilion having facets extending from the culet to the girdle. Clearly, there are many ways to cut a stone to bring about an aesthetically pleasing gemstone.

The reference fails to disclose a crown in the shape of symmetrical hemisphere. However, there are a multitude of patents disclosing a crown in the shape of a symmetrical hemisphere with rows of facets cut at varying angles along the outside surface of the hemisphere. See US Design Patents D35938, D43724, and utility patent 250378.

The Diagrams for Faceting discloses a Mogul cut having eight rows of crown facets cut at varying angles, but fails to disclose eleven rows of crown facets.

It would have been an obvious design choice to a person having ordinary skill in the art to cut eleven rows of crown facets in order to produce an aesthetically pleasing gemstone.

It also would have been obvious to make the crown in the shape of a symmetrical hemisphere with pavilion facets extending from the culet to the girdle in order to

produce an aesthetically pleasing gemstone. The design of the facets for a gemstone is considered to be an obvious design choice since the only thing that changes is the appearance of the gemstone. Furthermore, the applicant has failed to state any criticality with regard to their arrangement of facets on the stone, i.e. the effects that the arrangement has on the color, fire, clarity and/or brilliance of the stone.

(10) Response to Argument

With regard to the rejection of claim 25, the appellant argues on pages 7-9 that the "Diagram for Faceting" reference fails to disclose a hemi-spherical crown, and that the references fail to disclose eleven rows of crown facets. Agreed. However, the references to Schenck and Meyer both disclose hemi-spherical crowns. The applicant, in this argument, is attacking the primary reference without addressing the actual 103 rejections proffered by the examiner, i.e. "Diagram for Faceting" in view of Schenck and Meyer. The motivation to combine is found in the references. All of these references are concerned with beautifying the stone to make it more precious. This is done by cutting facets at varying angles, shapes, sizes and number into the surfaces of the stone. These facets produce varying clarity, color, brilliance and fire when viewing the stone. The skilled artisan would know how to cut the stone to produce the most appealing and beneficial effects. It would have been an obvious design choice to cut the stone with any variety of facet arrangements, shapes, sizes, and number in order to beautify the stone.

The applicant also argues that none of the references disclose an equal number of facets in each row. The examiner disagrees. The "Diagrams for Faceting" reference

on page 9 discloses a cut gemstone with a plurality of rows of crown facets formed at about the specified angles to the tangent of the top of the crown and an equal number of facets in each row. With regard to the angles, the claims state that the angles are “**about**” 15 degrees or “**about**” 19 degrees or “**about**” 25 degrees, etc. Clearly, the angles shown in the “Diagrams for Faceting” reference are “**about**” these specified angles.

The examiner would also like to point out that the courts have noted that matters relating to ornamentation only, which have no mechanical function, cannot be relied upon to patentably distinguish the claimed invention from the prior art. *In re Seid*, 161 F.2d 229, 73 USPQ 431 (CCPA 1947). According to the above conclusion, a cut stone would not be entitled to a utility patent unless the type, size, shape or angle of cut of the facets produce some unexpected result. The unexpected result criteria is used because one having ordinary skill in the art knows how to cut a stone based on the type, size, and clarity of the stone in order to produce the most precious stone possible. Cutting a stone to improve its clarity, brilliance, fire, and color (mechanical function) has been known for years. Therefore, there must be some unexpected result to prove that the type of cuts have in fact improved the brilliance, fire, clarity and color of the stone far above what would ordinarily be expected. Unless this result can be proved, the shape, size, and number of facets cut into a stone are considered to be for ornamental purposes only and cannot be used to patentably distinguish the appellant’s invention from the prior art.

(11) Related Proceeding(s) Appendix

No decision rendered by a court or the Board is identified by the examiner in the Related Appeals and Interferences section of this examiner's answer.

For the above reasons, it is believed that the rejections should be sustained.

This examiner's answer contains a new ground of rejection set forth in section (9) above. Accordingly, appellant must within **TWO MONTHS** from the date of this answer exercise one of the following two options to avoid *sua sponte dismissal of the appeal* as to the claims subject to the new ground of rejection:

(1) **Reopen prosecution.** Request that prosecution be reopened before the primary examiner by filing a reply under 37 CFR 1.111 with or without amendment, affidavit or other evidence. Any amendment, affidavit or other evidence must be relevant to the new grounds of rejection. A request that complies with 37 CFR 41.39(b)(1) will be entered and considered. Any request that prosecution be reopened will be treated as a request to withdraw the appeal.

(2) **Maintain appeal.** Request that the appeal be maintained by filing a reply brief as set forth in 37 CFR 41.41. Such a reply brief must address each new ground of rejection as set forth in 37 CFR 41.37(c)(1)(vii) and should be in compliance with the other requirements of 37 CFR 41.37(c). If a reply brief filed pursuant to 37 CFR 41.39(b)(2) is accompanied by any amendment, affidavit or other evidence, it shall be treated as a request that prosecution be reopened before the primary examiner under 37 CFR 41.39(b)(1).

Extensions of time under 37 CFR 1.136(a) are not applicable to the **TWO MONTH** time period set forth above. See 37 CFR 1.136(b) for extensions of time to

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reply for patent applications and 37 CFR 1.550(c) for extensions of time to reply for ex parte reexamination proceedings.

Respectfully submitted,

Jack W. Lavinder



A Technology Center Director or designee must personally approve the new ground(s) of rejection set forth in section (9) above by signing below:


Donald Hajec

Director TC3600

Conferees:

Michael Mansen

Judy Swann